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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,678	10/07/2003	James C. Crone	5164-001	5430

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EXAMINER

ZEENDER, FLORIAN M

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,678

Applicant(s)

CRONE, JAMES C.

Examiner

F. Ryan Zeender

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC §101

Claims 1-7 and 9-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-7 and 9-10 only recite an abstract idea. The recited steps of merely selling a meal, collecting a price, and transferring an amount, do not necessarily apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to facilitate charitable contributions.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

invention produces a manner to give to charity which meets the “useful, concrete, and tangible” criteria.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-7 and 9-10 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

Claims 1-6, 11-14, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helbling ‘518.

Helbling discloses means of facilitating charitable giving by a restaurant, including: selling a reduced portion meal product (i.e., meal without a beverage, *since beverages are free with donation; see for example, Col. 4, lines 42-47*) at a customer price higher than the reduced portion meal price (i.e., reduced meal price plus excess minimum donation amount); transferring the excess amount to a charity on behalf of the customer.

Helbling lacks the teaching of the customer price corresponding to the full-portion meal product price (i.e., reduced portion meal price plus beverage price); and transferring only part of the excess amount to charity.

It would have been an obvious design choice at the time of the invention to have the customer price correspond to the full portion meal price (i.e., have the minimum donation amount equal the beverage price) in order for the charities to receive more money without the customers feeling like they’ve overpaid.

Further, specifically regarding claims 1, 4, 11, and 20; it is well known in business for a company to receive a processing/handling/operating fee for work performed, therefore, it would have been obvious to one of ordinary skill in the art to transfer only part of the excess amount to charity.

Re claims 3 and 19: See Helbling, Col. 4, lines 29-30.

Re claim 5: See Helbling, Col. 4, lines 35-38.

Re claims 6 and 12: See Helbling, Col. 4, lines 42-43.

Re claim 14: It is well known for fast food franchises to include multiple restaurants.

Claims 7-10 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helbling '518, as applied to claims 1 and 11 above, and further in view of Burke '682.

Helbling teaches the limitations of the claims, as described above, but lacks the specific teaching of the customer providing a unique identifier, tracking customer donations across multiple sales, and providing the customer with a summary of donations over a predetermined period.

Burke teaches a similar means for facilitating charitable contributions including the use of a magnetic stripe donor card (see for example, Col. 3, lines 21-23) that tracks customer donations and prints out periodic reports (see for example, Col. 2, lines 58-59).

It would have been obvious to one of ordinary skill in the art to modify Helbling to have the customer provide a unique identifier, track customer donations across multiple sales, and provide the customer with a summary of donations over a predetermined period, as taught by Burke, in order to provide the customer with accurate records for tax purposes (See for example Burke, Col. 12, lines 63-65).

Response to Arguments

Applicant's arguments filed 12/22/2004 have been fully considered but they are not persuasive.

Re. Rejection under 35 USC 101:

The invention in the body of the claims must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished). Also note MPEP 2106 IV 2(b).

In Bowman, the board affirmed the rejection under U.S.C 101 as being directed to non-statutory subject matter. The Board held that the disclosed and claimed invention is directed merely to a human making mental computations and manually plotting results on paper chart, and thus is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the constitution. The abstract idea does not become a technological art merely by the recitation in the claim of "transforming physical media into a chart" and "physically plotting a point on said chart."

Claims 1-7 and 9-10 do not recite steps within the technological arts, as explained above, and are deemed to be directed toward non-statutory subject matter. Therefore, the rejection is proper and has been maintained.

Re. Rejection under 35 USC 103:

On page 8, first full paragraph, and on page 9, first paragraph, the applicant argues limitations that are not claimed; specifically, the customer's contributions are purely altruistic and the restaurant does not contribute anything. Because the limitations are not claimed, the arguments are not persuasive.

On page 8, second paragraph, the applicant argues that Helbling does not define a "meal" as including a beverage. However, it is known in the industry that a "meal" includes a beverage. For example, McDonald's serves a "happy meal" that includes a beverage. The applicant further argues that Helbling does not define a customer accepting a free beverage being a reduced-portion meal purchase. However, since the customer is not "purchasing" the beverage from the restaurant, he/she is effectively purchasing a reduced-portion meal, since there are less goods being actually "purchased".

On page 8, last paragraph, the applicant argues that the specification clearly defines a reduced-portion meal product as comprising the same elements as its corresponding full-portion meal product, but in reduced quantities. However, the specification, in its entirety, does not clearly define the terminology, as necessitated by MPEP 2111.01(III), in that the language on page 5, lines 18-20, makes the definition of

"a reduced-portion meal product" ambiguous. Therefore, the argument is not convincing.

On page 9, second paragraph, the applicant argues that there is no motivation to modify Helbling to make the minimum donation amount equal the beverage price. The applicant states that a modification "would eliminate all incentive for customer participation". However, this is not true because the customer would still get the beverage "free" (by not actually paying the restaurant) while being able to contribute to charity. Further, the customer would be able to benefit financially due to a tax "write-off" for the donation. Therefore, there continue to be incentives for the customer to contribute. The motivation provided in the rejection above to modify Helbling is proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

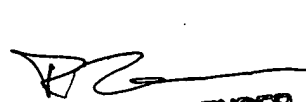
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (703) 308-8351. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on (703) 308-5183. The receptionist's phone number for the Technology center is (703) 308-1113.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

F. Zeender
Primary Examiner, A.U. 3627
February 1, 2005

 2/1/05
F. RYAN ZEENDER
PRIMARY EXAMINER